

REMARKS/ARGUMENTS

Claims 1-18, 20 and 21 are pending. By this Amendment, claims 1-18 are amended. Support for the amendments to claims 1-18 can be found, for example, in original claims 1-18. The amendments to claims 1-18 are made solely to improve their clarity. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Rejections Under 35 U.S.C. §103

A. Maruyama and Peterson

The Office Action rejects claims 1-18, 20 and 21 under 35 U.S.C. §103(a) over U.S. Patent No. 4,264,743 to Maruyama et al. ("Maruyama") in view of U.S. Patent No. 4,386,166 to Peterson et al. ("Peterson"). Applicants respectfully traverse the rejection.

Claim 1 recites "[a] water-impermeable flexible polyurethane foam obtained by: reacting a polyol component with at least one polyisocyanate component in the presence of a foaming agent; wherein: the polyol component comprises at least one hydrophobic polyol; the foam has a compression force of less than or equal to 12 kPa for 50% compression; and a molar ratio of isocyanate functional groups to a total of alcohol functional groups and reactive functional groups (the index) is less than 0.90" (emphasis added). Maruyama and Peterson do not disclose or suggest such a foam.

The Office Action relies on Maruyama for its disclosure of a polyurethane foam obtained by reacting a hydrophobic polyol, a polyisocyanate and a blowing agent. *See* Office Action, page 2; Maruyama, Abstract. The Office Action concedes that Maruyama does not disclose the compression force or the NCO index of claim 1. *See* Office Action, pages 2 to 3. However, the Office Action asserts that the compression force in claim 1 is inherent in the foams of Maruyama and that it would have been obvious to modify the NCO

index required by Maruyama to obtain the composition of claim 1. *See* Office Action, pages 2 to 3. Applicants respectfully disagree.

To modify the teachings of Maruyama by modifying the NCO index to fall within the scope of claim 1 would require ignoring the requirement in Maruyama of a NCO index of 0.90 or greater. *See* Maruyama, column 8, lines 24 to 26. Maruyama teaches away from employing an NCO index as recited in claim 1 stating that the "... (NCO) index must be 0.9 or higher." *See* Maruyama, column 8, lines 25 to 26 (emphasis added). The Office Action has failed to provide a reasonable basis for its assertion that one of ordinary skill in the art would have disregarded the guidance of Maruyama and employed an NCO index as recited in claim 1. *See* MPEP §2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) ("A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.").

Maruyama does not explicitly disclose a foam having a compression force of less than or equal to 12 kPa for 50% compression. It is well-settled that "[t]he fact that certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of the result or characteristic." *See* MPEP §2112.IV (citing *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993)) (emphasis in original). Applicants submit that the foams of Maruyama do not necessarily have compression force of claim 1. In particular, Applicants direct attention to Comparative Example 1 of the present specification, which is a foam composition corresponding to a foam according to Maruyama. *See* present specification, page 2, line 22 to page 3, line 6, page 9, lines 19 to 22. As is evident from the experimental results in the present specification, such foam does not have a compression force of less than or equal to 12 kPa for 50% compression. *See* present specification, Table 1. Accordingly, it

is not possible to assert that the foams of Maruyama necessarily (and thus inherently) have the compression force of claim 1.

As Maruyama fails to disclose or suggest the compression force or NCO index of claim 1, Maruyama fails to disclose or suggest each and every feature of claim 1.

For the reasons discussed above, Maruyama fails to disclose or suggest each and every feature of claim 1. Peterson does not remedy the deficiencies of Maruyama. Peterson is cited for its alleged disclosure of manufacturing foams by casting on a conveyor belt and passing the belt through an oven. *See* Office Action, page 3. However, Peterson, like Maruyama fails to disclose or suggest the compression force or NCO index of claim 1. Accordingly, the combination of references fails to disclose or suggest each and every feature of claim 1.

As explained, claim 1 would not have been rendered obvious by Maruyama and Peterson. Claims 2-18, 20 and 21 depend from claim 1 and, thus, also would not have been rendered obvious by Maruyama and Peterson. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Fujita and Peterson

The Office Action rejects claims 1-18, 20 and 21 under 35 U.S.C. §103(a) over U.S. Patent No. 5,527,834 to Fujita et al. ("Fujita") in view of Peterson. Applicants respectfully traverse the rejection.

Claim 1 is set forth above. Fujita and Peterson do not disclose or suggest such a foam.

In preparing the disclosed foam, Fujita suggests employing a mixture of a hydrophobic polyol (polyhydric alcohol) with one or more other polyols. *See, e.g., Fujita*, column 2, lines 16 to 28. Claim 1, by contrast does not require such a polyol phase. One of

ordinary skill in the art would appreciate that, in view of the foregoing and viewing the Examples of Fujita, the compositions of Fujita have an NCO index that is greater than 0.9, while claim 1 requires an NCO index of less than 0.90.

Applicants further note that Fujita requires that 7 to 100 parts of an ester compound be used as an additive in preparing the disclosed foam. See Fujita, column 2, lines 32 to 47. Claim 1 does not require such a component. Due to the differences, e.g., between the compositions employed in the Examples of the present specification and the Examples of Fujita, one of ordinary skill in the art would not conclude that the foams of Fujita do not necessarily have properties corresponding the properties of the foam of claim 1.

For the foregoing reasons, Fujita fails to disclose or suggest a foam as recited in claim 1.

For the reasons discussed above, Fujita fails to disclose or suggest each and every feature of claim 1. Peterson does not remedy the deficiencies of Fujita. Peterson is cited for its alleged disclosure of manufacturing foams by casting on a conveyor belt and passing the belt through an oven. See Office Action, page 5. However, Peterson, like Fujita fails to disclose or suggest a foam as recited in claim 1. Accordingly, the combination of references fails to disclose or suggest each and every feature of claim 1.

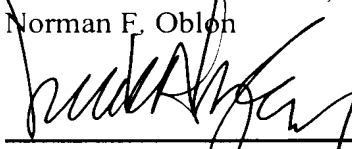
As explained, claim 1 would not have been rendered obvious by Fujita and Peterson. Claims 2-18, 20 and 21 depend from claim 1 and, thus, also would not have been rendered obvious by Fujita and Peterson. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

For the foregoing reasons, Applicants submit that claims 1-18, 20 and 21 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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